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IN THE

Supreme Court of the United States

October Term, 1967.

No. 249

ANCHOR HOCKING GLASS CORPORATION,
Petitioner,

v.

CORNING GLASS WORKS.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

ANCHOR HOCKING GLASS CORPORATION, your petitioner, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit, entered in the above-entitled case on March 20, 1967.

OPINIONS BELOW.

The opinion of the District Court (13a-47a; 245b-279b) is reported at 253 F. Supp. 461.[1] The opinion of the court below (Appendix A, *infra*, pp. A1-13) is reported at 374 F. 2d 473.

JURISDICTION.

The judgment of the court below (Appendix B, *infra*, p. A14) was entered on March 20, 1967. Jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

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1. The record as printed for the court below consists of three volumes filed by respondent Corning Glass Works (hereinafter "Corning" throughout), which are paged consecutively with the suffix "a", and of two volumes filed by petitioner Anchor Hocking Glass Corporation (hereinafter "Anchor" throughout), which are similarly paged consecutively, but with the suffix "b".

Accordingly, every parenthetical record citation with the suffix "a" refers to Corning's Appendix, while every citation with the suffix "b" means Anchor's Appendix.

QUESTIONS PRESENTED.

1. Whether a limitation inserted into the claims of a patent in the course of their prosecution to distinguish over the prior art and to obtain their allowance, may, in the face of the doctrine of file wrapper estoppel, be excised from the claims by an appellate court to validate the patent.

2. Whether a patent is entitled to a wider and more liberal breadth of protection as a "pioneer patent" where the course of proceedings in the Patent Office shows a series of rejections of all claims by the examiner on the ground they were unpatentable over the prior art, each of which was followed by amendments to the patent application, some supported by affidavits of questionable accuracy, and in one instance by the personal intervention of a retired former immediate superior of the examiner, who had been retained as a consultant by the prospective patentee.

3. Whether, assuming that a patent so obtained is indeed a "pioneer patent", it is entitled to have its claims, which 35 U. S. C. § 112 requires to be definite, judged by a lower standard of definiteness than are other patents.

4. Whether, where the trial court found that the claims of a patent—which had been limited in the course of their prosecution to articles containing at least 50% crystals—were indefinite and invalid for failure to comply with 35 U. S. C. § 112 because "lengthy independent experimentation" was necessary to devise a test to determine whether the limitation was applicable, an appellate court may avoid the thrust of the statute by excising the limitation from the claims in order to validate the patent.

STATUTES AND RULE OF COURT INVOLVED.

1. Section 112 of 35 U. S. C. provides in pertinent part:

"§ *112. Specification.*

* * *

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

2. Section 282 of 35 U. S. C. provides in pertinent part:

"§ *282. Presumption of Validity; Defenses.*

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

* * *

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title.

(4) Any other fact or act made a defense by this title."

3. Rule 52(a) of the Federal Rules of Civil Procedure provides in pertinent part:

"*Rule 52. Findings by the Court.*

(a) Effect. * * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

STATEMENT.

This case involves the validity of Stookey patent No. 2,920,971 (275a-283a; 281b-289b), issued to Corning January 12, 1960 on an application filed June 4, 1956. The patent is directed to a two-step heat treatment for crystallizing an endless variety of conventional glasses containing from 2-20% TiO_2 (titania). The first step is stated to produce invisible nuclei of TiO_2 throughout the glass and the second step, conducted at a somewhat higher temperature, causes crystallization on these nuclei of other crystallizable ingredients. All of the claims require at least 50% of the weight of the final product to be crystallized. The products produced by this treatment are asserted to have improved physical and dielectric properties. There are 21 patent claims, 11 directed to the two-step heat treatment and 10 to the resulting products (14a-15a, 16a; 246b-247b, 248b).

It should be noted here, by way of obviating any possible misunderstanding, that the patent in suit does not disclose either the specific glass composition or the specific heat treatment for making the widely advertised and commercially successful product CORNING WARE. But the extremely broad claims of this patent cover CORNING WARE and innumerable other products not yet developed. Both the formulation and the heat treatment used to produce CORNING WARE are based upon subsequent developments of other scientists covered by later patents not involved in this case (468b-469b; 44b-45b).

The District Court held the patent in suit invalid under 35 U. S. C. § 112 (*supra*, page 1) because, while the claim language of 50% crystallinity was not indefinite *per se*, percent crystallinity of the end product could not be measured accurately at the time the patent issued, and moreover "costly and lengthy independent experimentation" was necessary to devise a test to make this measurement (44a;

276b).[2] This measurement is required by all the claims in the patent. The District Court made the following key findings (44a-45a; 276b-277b):

> ". . . Even though the Patent Office did not require the 50% limitation in the patent, the patentee included this limitation and relied upon it to distinguish his patent from the prior art. Consequently, the public is entitled to experiment in this glass ceramic area and related fields up to the 50% crystallinity without being compelled to independently experiment to determine the limits of the patent claims."
>
> * * *
>
> "In 1956 two weeks before the patent application, Corning's records show that it was impossible to determine percent crystallinity by X-ray diffraction. In 1958 Corning was still unable to determine percent crystallinity of a glass ceramic by either X-ray diffraction or electron microscopy, although it was possible to determine this percentage roughly by chemical analysis. Finally, by 1964, with the help of new techniques which were developed after a year of independent experimentation, Corning's experts were able to make an estimate of the crystallinity in the glass ceramics within a 4 to 5% range of error. A description of this new technique was first published in 1964, about eight years from the time of the patent application and four years after it was issued."

The District Court went on to hold that, as a matter of law (44a-45a; 276b-277b):

> ". . . A patentee cannot foist a great financial burden on another to develop a new measurement tech-

2. But the District Court sustained the patent against contentions of lack of invention and novelty, and rejected as well Anchor's allegations of fraud, unclean hands, and inoperativeness (17a-41a; 249b-273b).

nique to determine whether he is infringing the patent."

Accordingly, since the District Court found that neither Corning nor Anchor was able, despite numerous expensive tests, to determine percent crystallinity within a 7 to 10% range of error, at the time the patent issued, the patent was held invalid (46a, 48a; 278b, 280b).

On appeal, the court below reversed—holding that the Stookey patent was a "pioneer patent", so it was entitled to a broader construction, and that accordingly "the District Court erred in finding Corning's patent to be unenforceable, since the standards placed upon this particular patent were, as a matter of law, too strict" (*infra*, p. A6).

The court below further held that "In interpreting the claims and specifications the District Court relied too heavily on the 50% crystallinity standard set forth in the patent" (*infra*, p. A9). In support, it cited Stookey's testimony that the percentage of crystallinity was not critical, and it expanded the scope of the claims so that the patent's sphere of protection will extend down to at least 40% crystallinity (*infra*, pp. A9-10). This reconstruction of the claim language supposedly overcame the 7-10% margin of error found by the trial court to be inherent in the crystallinity measurements (*infra*, A10-11).

Upon adopting this construction, the court below disagreed with the District Court's findings that the tests to determine crystallinity were difficult and expensive; held that the patent claims now complied with 35 U. S. C. § 112; sustained the Stookey patent against all contentions made against it; and reversed the judgment with instructions to consider the issue of infringement (*infra*, pp. A12-14).

Since the decision below depended in large part upon the court's characterization of the patent as a "pioneer", a brief discussion of the patent application history is in order.

A. Prosecution of Corning's Application Through the Patent Office.

Corning's application for the Stookey patent had a long path to tread after it reached the Patent Office in order to overcome the prior art. Before Corning was awarded a patent, there were no less than four rejections on the part of the Patent Office, which Corning met with six amendments to the application supported by numerous *ex parte* affidavits, and four personal interviews with the patent examiner (330b-332b; 333b-334b; 338b-346b; 362b).

1. *First rejection:* After the patent application was filed the patent examiner rejected the claims on March 7, 1957 as anticipated by the prior art (295b-297b) which included Corning's Armistead patent issued three years previously. The Armistead patent, like the patent at bar, describes a two-step heat treatment for crystallizing glasses containing from 8 to 25% TiO_2, the first step producing invisible nuclei of TiO_2, and the second step conducted at a higher temperature causing crystallization on these nuclei (401b-404b). Armistead's products are stated to have the ability to withstand higher temperatures than uncrystallized glasses (402b). The trial court found that Armistead's untreated compositions were included within the compositions of the patent in suit and if they were "held at the recrystallization temperature long enough" the products of the patent in suit could be formed (21a, 29a-30a; 253b, 261b-262b).

2. *First Amendment:* Corning amended its application on August 9, 1957, and sought to distinguish over the Armistead prior art by experiments reported in an affidavit of Dr. Witucki, one of its research chemists (298b-314b). The rejection on Armistead had been expected even before the Stookey application was filed and Witucki had conducted his affidavit experiments beforehand (472b; 14b; 115b-117b).

The Witucki affidavit was attacked by Anchor at the trial on the ground it was misleading. But the District Court found that this affidavit involved no intentional misstatements, however ambiguous or equivocal it might be because "It is a matter of opinion as to what the result proved" (31a; 263b) and "The implications of the affidavit are what the reader wishes to place there" (31a; 263b)—even though, contrary to the import of the affidavit, the Witucki experiment "departed from the actual heat treatment of an Armistead thermometer glass" (33a, N. 32; 265b N. 32).[3]

3. *Second Rejection:* Notwithstanding the foregoing amendment and request for reconsideration, the examiner once more rejected all the claims as unpatentable over the prior art, on April 1, 1958 (315b-317b).

4. *Second Amendment:* At this time Corning enlisted the services of a retired former immediate superior of the examiner, who studied the application file and recommended that to overcome the examiner's rejection all the claims should require the presence of at least 50% crystals (487b-491b). An amendment was prepared limiting all claims in this manner and urging that this limitation distinguished the claims from the prior art Armistead patent (381b-329b, 324b, 325b).

This amendment was filed in September, 1958. The following month, Corning's patent solicitor and the former superior of the examiner met with the examiner and attempted to convince him that the claims were patentable (237b, 239b-240b). In a post-interview supplementary amendment, Corning again stressed 50% crystallinity (330b-332b).

5. *Third Amendment:* After a second interview Corning further amended its application under date of

3. The District Court's statement that Anchor did not urge this point as a significant deviation overlooked page 20 of Defendant's Post-Trial Brief filed in the District Court.

March 16, 1959 (333b-334b), by designating it a "continuation in part" of an earlier Corning application.

6. *Third Rejection:* On May 13, 1959 the examiner withdrew his rejection of the claims as unpatentable over Armistead alone, but rejected them as unpatentable over a combination of Armistead and a newly cited reference—Watson (392b-394b). He relied on Armistead as showing the glass-making compositions covered by Stookey's claims were crystallizable, and he relied on Watson to show that the two-step heat treatment of the claims to produce crystallization was also old (335b-336b). The Watson patent described a method of subjecting basalt glasses to a two-step heat treatment to produce completely "devitrified [crystallized] articles without failure." The Watson patent further stated that these articles had improved strength and insulating qualities (392b-393b).

7. *Fourth Amendment:* Early in August, 1959, Corning filed another amendment to overcome the newly cited Watson patent (337b-346b). This amendment was accompanied by an affidavit of Cyrus Klingsberg, another one of its research chemists (347b-349b). In the memorandum forming part of the amendment, Corning took the position that basalts do not contain titania (TiO_2) and therefore Watson did not disclose the same method of crystallization as Stookey's application; *i.e.*, crystallization on titania nuclei. The District Court was troubled by this representation (39a; 271b; footnote omitted):

> ". . . Nevertheless, one bothersome point remains and that is the representation by plaintiff's patent solicitor to the patent examiner that basalts do not contain TiO_2. Undoubtedly, this statement is false since all basalts contain some TiO_2. However, the evidence indicates that the statement was innocently made."

The trial court concluded that the statement was innocent because the same solicitor had recently filed another application conceding that basalts do in fact contain TiO_2. The court said (39a-40a; 271b-272b):

> ". . . It is impossible for this Court to conclude that an attorney, especially one familiar with patent application procedures, would have made such contradictory statements which were readily apparent and subject to the scrutiny of the same patent examiner, unless innocently made."

8. *Fourth Rejection: First Partial Allowance.* The foregoing amendments, affidavits and interviews finally caused the examiner to allow eleven claims on September 4, 1959, but he still rejected eight others as unpatentable over the prior art (350b-352b).

9. *Fifth Amendment:* On September 18, 1959, Corning once again amended (353b-356b) reasserting the Klingsberg affidavit and adding by way of additional support an affidavit of another of its research chemists, Herbert D. Kivlighn (357b-359b). Kivlighn, like Klingsberg, reported experimental results purportedly showing that Watson's method produced an entirely different product than Stookey's.

The Kivlighn affidavit also was attacked at trial on the ground it was misleading and helped to deceive the examiner as to the pertinency of the prior art. But the District Court stated, "The implication of the affidavit is what one wishes to draw" (37a; 269b). "The choice was left to the one attempting to follow it" (37a; 269b).

10. *Fifth Action: Second Partial Allowance:* Shortly after the September 16th Amendment, the examiner allowed nine more claims and held one more allowable subject to cancellation of another (360b-361b).

11. *Sixth Amendment:* Corning complied (362b), and the patent finally issued on January 12, 1960 with all claims limited to the presence of at least 50% crystals (281b-289b).

B. Indefiniteness of the Patent in Suit.

As has been indicated above, the District Court held the patent invalid for indefiniteness, in the light of the requirements of 35 U. S. C. § 112 (*supra,* p. 4), because at the time the patent issued, lengthy independent experimentation was required to devise a test to measure the percentage of crystallinity of the product.

The District Court noted, in language already quoted above, p. 5, that "Even though the Patent Office did not require the 50% limitation in the patent, the patentee included this limitation and relied upon it to distinguish his patent from the prior art. Consequently, the public is entitled to experiment in this glass ceramic area and related fields up to the 50% crystallinity without being compelled to independently experiment to determine the limits of the patent claims ". . . . A patentee cannot foist a great financial burden on another to develop a new measurement technique to determine whether he is infringing the patent" (44a-45a; 276b-277b).

In view of the ruling below on the point, it is necessary to set forth in full the District Court's findings that neither Corning nor Anchor had been able despite numerous expensive tests to determine percent crystallinity within a 7 to 10% range of error (45a-46a; 277b-278b; footnotes omitted):

> "The patent in suit states that the percent crystallinity could be determined by X-ray diffraction, the only test described. However, Corning at the time of its patent application, had not measured any of the various examples in its patent for percent crystallinity and Corning's witnesses admitted that it would take too long and be too difficult to measure the examples for percent crystallinity.

"In 1956 two weeks before the patent application, Corning's records show that it was impossible to determine percent crystallinity by X-ray diffraction. In 1958 Corning was still unable to determine percent crystallinity of a glass ceramic by either X-ray diffraction or electron microscopy, although it was possible to determine this percentage roughly by chemical analysis. Finally, by 1964, with the help of new techniques which were developed after a year of independent experimentation, Corning's experts were able to make an estimate of the crystallinity in the glass ceramics within a 4 to 5% range of error. A description of this new technique was first published in 1964, about eight years from the time of the patent application and four years after it was issued.

"Between the time the patent issued and the sale of its commercial products, Anchor spent a great deal of time and money trying to measure the percent crystallinity in its proposed commercial products. Anchor spent over $100,000 to determine the percent crystallinity; however, this includes the cost of an X-ray machine and the cost of training personnel to operate it. The training and equipment costs are irrelevant for a patentee does not have to pay the cost of teaching competitors to use measurement equipment or buy it. But, it cannot foist upon them the cost of developing a technique, which is not commonly known or available. Furthermore, Anchor had to obtain the help of four independent research sources to devise tests methods before being able to determine percent crystallinity within the 7 to 10% range of error. For this reason, the patent must be held invalid . . ."[4]

4. At the present time crystallinity measurements of glass-ceramics are notoriously inaccurate. Thus, chemical analysis, a technique never suggested in the literature (86b), permits only a "rough" determination, as found by the trial court (45a; 277b). And Corning's experts illustrated the inaccuracy of the two other available tech-

Accordingly, the District Court entered final judgment in favor of Anchor in respect of the invalidity of Corning's patent but dismissed Anchor's counterclaims based upon its allegations of fraud on the Patent Office (48a; 280b).

C. The Ruling Below.

As has been indicated, the court below reversed. Although it agreed that, "Juxtaposed against the narrow interpretation of the patentee's claims the result reached by the District Court was inevitable" (*infra*, p. A9), it held that since the Stookey patent was a "pioneer patent", the standards placed upon the patent by the District Court were, as a matter of law, "too strict" (*infra*, p. A6) and that the patent is entitled to a broader construction. Applying a broader construction it then found that ". . . the Stookey patent's sphere of protection will extend to 40% crystallinity" (*infra*, p. A10).

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niques, electron microscopy, and X-ray diffraction. With X-ray diffraction, one expert got 40% crystals while with the electron microscope another expert got 66% crystals for the *same* product (63b).

Each technique is plagued with error-producing factors. Thus, to measure crystallinity of each composition by X-ray diffraction requires "a great deal of luck and plenty of years of work" (137b-138b), while measurement by the electron miscroscope, a technique developed after the patent issued, depends upon the untested assumption that a small number of photomicrographs, each one showing an area one-hundred thousandth the size of a common pinhead are representative of the entire product (61b-63b; 66b-67b).

Because of these problems, none of the examples of Corning's patent had been measured for percent crystallinity at the time the patent issued (7b; 208b), none of the examples refer to the percent crystallinity of the products described, and even Corning's scientists (Stookey and Armistead) admitted such crystallinity measurements would have taken fifty years to make (207b, 117b). At no time during the prosecution of the patent application did Corning disclose these facts to the Patent Office.

REASONS FOR GRANTING THE WRIT.

Rarely does a decision wipe out at a single blow so many doctrines heretofore settled by this Court as the one now sought to be reviewed—or open up so wide a field for the profitable exercise of improper monopoly.

For here the court below permitted the patentee, Janus-like, to speak out of one mouth to persuade the Patent Office that a limitation was important and then to speak out of the other to convince the appellate court that it was not. Thus the decision jettisons completely the very heart of the doctrine of file wrapper estoppel. Moreover, the court below disregarded both facts and law in labeling the patent in suit a "pioneer", and then compounded that error by brushing aside the established rule that pioneer patents like all others must state their claims with definiteness—thus formulating a dual standard of definiteness under 35 U. S. C. § 112.

First: The most far reaching—and most dangerous—departure from hitherto settled patent doctrine appears in the utter disregard by the court below of the doctrine of file wrapper estoppel, the rule that limitations introduced to distinguish claims from the prior art cannot subsequently be disregarded or construed to recoup what was given up.

Very briefly, after Corning's application had been twice rejected as unpatentable over the prior art, it amended its claims to assert that the product was at least 50% crystalline, and it argued that this limitation distinguished its claims from the prior art cited by the examiner. See *Second Amendment, supra,* p. 8.

That was Corning's patent office position. In litigation, however, Corning changed its tune; the inventor testified as a witness in court that the 50% limitation was unimportant (*infra,* pp. A9-10). The District Court very properly held Corning to its earlier position, saying

(44a; 276b) that "Even though the Patent Office did not require the 50% limitation in the patent, the patentee included this limitation and relied upon it to distinguish his patent from the prior art."

For this it was criticized—and reversed—by the court below (*infra,* pp. A6-A13, A14), which held—"In our view the District Court erred in finding Corning's patent to be unenforceable, since the standards placed upon this particular patent were, as a matter of law, too strict" (p. A6). "In interpreting the claims and specifications the District Court relied too heavily on the 50% crystallinity standard set forth in the patent" (p. A9).

Disregarding the prosecution history of the patent, shutting its eyes to the indisputable fact that Corning had itself inserted that standard to show novelty in the face of multiple rejections based on the prior art, the court below relied instead on the inventor's self-serving testimony at trial that the 50% standard was unimportant (*supra,* p. 6).

Plainly, such reasoning places a profitable premium on shifts and turns by a patentee, on taking one position to get a patent allowed and then changing to a position precisely opposite when the patent is litigated. Equally plainly, the reasoning of the court below wipes out at one blow the settled doctrine of file wrapper estoppel, long insisted on by this Court, and only very recently reaffirmed, *Graham v. John Deere Company of Kansas City,* 383 U. S. 1, 33: "Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and *claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent.*" [Italics added]

Second: The characterization of the patent in suit by the court below as a "pioneer patent" is a demonstrable misstatement of both fact and law: of fact because it

ignores completely the long and difficult course of the patent's prosecution history; of law because it nullifies this Court's standards on the nature of a "pioneer patent."

No one reading, much less studying, the opinion below would ever learn therefrom that the claims of the present Corning patent had been several times rejected as unpatentable over the prior art in a crowded field, or that those claims had evolved from six amendments supported by several affidavits of questionable accuracy before the patent issued, or that the road to allowance of the application required the timely intervention of the examiner's former superior, whom Corning recalled from retirement to serve as its "consultant" and in that capacity to argue with the examiner. It is for these reasons that we have set forth above the prosecution history of the present patent at some length (*supra,* pp. 7-11).

Nor does the patent in suit meet this Court's restrictive definition of a "pioneer patent." That expression has always been sparingly applied, as "covering the achievement of the desired result in its widest form, unlimited by specific details." *Gordon v. Warder,* 150 U. S. 47, 53-54, or as "covering a function never before performed, a wholly novel device, or one of such novelty and importance as to mark a distinct step in the progress of the art, as distinguished from a mere improvement or perfection of what had gone before." (*Boyden-Power Brake Co. v. Westinghouse,* 170 U. S. 537, 561-562).

The accolade of pioneer has been charily applied indeed, to the Howe sewing machine, to the Morse telegraph, to the Bell telephone (*ibid.,* at 562). Westinghouse's first air brake qualified (*ibid.*), so did Marconi's first radio transmitter; but later improvements on these devices did not. *Boyden-Power Brake Co. v. Westinghouse, supra; Marconi Wireless T. Co. of America v. United States,* 320 U. S. 1.

To accept the characterization of the present patent as a "pioneer" is to substitute sloganeering for facts, to ignore the mass of documentary proof in the record contra-

dicting that label and to brush aside this Court's strict standards.

Third: But even if for purposes of argument—and in disregard both of the present record and of prior decisions here—we accept the characterization of "pioneer" in this case, that concession still does not sustain the decision below. For it has long been plain that pioneer patents, like all others, are subject to the general principles governing—and limiting—all other patents. The public must be protected from uncertainty in patent claims, whether they be for pioneer inventions or otherwise.

Neither the possible commercial value of the invention nor the reputation of the inventor permit these principles to be relaxed. As said in the *Marconi* case (*supra,* at 37-38), "Marconi's reputation as the man who first achieved successful radio transmission * * * however well-deserved, does not entitle him to a patent for every later improvement which he claims in the radio field. Patent cases, like others, must be decided not by weighing the reputations of the litigants, but by careful study of the merits of their respective contentions and proofs."

Specifically, the standards of definiteness now codified in 35 U. S. C. § 112 (*supra,* p. 3) have been held equally applicable to basic, i.e., pioneer patents. "Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery." *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, 369; *United Carbon Co. v. Binney & Smith Co.*, 317 U. S. 228, 232.

By reading a double standard of definiteness into the statute now in suit (assuming arguendo that the patent is of a pioneer character) the court below has nullified the command of 35 U. S. C. § 112 and the holdings of a long line of decisions here construing that statute. By the device of characterizing a patent as a "pioneer" it has replaced the certainty of the statute with a double standard never intended by Congress.

Although the court below concluded that the liberal interpretation which it accorded the patent claims met the

lower standard of definiteness required of a pioneer patent, in fact it simply shifted the 7-10% margin of error (which the District Court found to be inherent in 1960 crystallinity measurements) from the 50% level to the 40% level. But to come within this margin of error still required "costly and lengthy independent experimentation" to devise a measurement test. Corning's selection of such claim language is particularly inexcusable here as it could instead have relied upon physical and electrical properties capable of simple and economical determination (66a-67a; 8b-9b; 17b-24b).

The District Court recognized the 50% limitation for what it truly is—a phantom limitation—numerically definite, but unsusceptible of measrement by known tests and with the degree of precision required by 35 U. S. C. § 112. Indeed, such a limitation should be held indefinite *per se*. But instead, the court below reconciled it with the requirements of § 112, thereby placing its *imprimatur* on the use of phantom terms, and providing added incentive for the further proliferation of the already highly developed art of "opaque" drafting of patent claims recently criticized by this Court in *Brenner v. Manson*, 383 U. S. 519, 534, 538.[5]

Fourth: The decision below calls for review because of the immense importance of the patent in suit to the public generally and to the entire glass industry specifically. Before the decision of the District Court the public could at least experiment with products containing less than

5. The court below also said (*infra*, p. A11), "Examining the District Court's narrowly interpreted conclusion in a more favorable posture toward the patentee, it is clear that Anchor was not unduly burdened in establishing the bounds of the Corning patent" and then went on to differ with the District Court's findings (*supra*, p. 12), as to the difficulties in determining the degree of crystallinity claimed in the patent. In the event that certiorari is granted, we shall also demonstrate that the District Court's findings in regard to the tests required to measure crystallinity were amply supported by the evidence, and that the treatment of those findings by the court below (*infra*, pp. A11-12) violated the plain terms of Rule 52(a) F. R. Civ. P. (*supra*, p. 3), and laid down a rule of law which is contrary to this Court's decisions.

50% crystals. The problem, which the District Court recognized, was determining how to devise a test for measuring what fell within that range. The court below, however, further extended the reach of the patent's monopoly to both crystalline and semi-crystalline products comprised of at least 40% crystals (*infra,* A10). Where the boundaries of the patent monopoly will eventually be drawn is uncertain, and thus it is doubtful whether anyone will have sufficient temerity to venture into this important field in the face of its aggressive domination by Corning and the consequent threat of litigation. Thus, as a practical matter, virtually all experimentation by competitors in this field will be foreclosed for at least a decade.

As the record shows, Corning's annual sales of products covered by the patent have exceeded one hundred million dollars (80-81a; 82a). Furthermore the growth potential of this market is unlimited (68-71a; 303-306a).

In fact, so extensively did Corning dwell on the versatility and commercial potential of these products that the two lower courts were mesmerized into believing that the patent represented a wholly unique and unprecedented break-through in glass technology—despite its precarious history in the Patent Office (*supra,* pp. 7-11). Actually, the patent is one of a series of patents which Corning has obtained for similar developments. All relate to products with improved physical features obtained by a controlled two-step crystallization process. Armistead (401-404b) and Blau (395-400b) were first in the series; then came Stookey's FOTOFORM invention discussed by the court below (*infra,* p. A7); next came the patent in suit. Since its issuance, several other related patents have been granted to Corning including the two relating to the formulation and heat treatment of CORNING WARE (*supra,* p. 4).

Anchor is the only competitor marketing an allegedly infringing product. Thus, if the decision below is allowed to stand, Corning will, as a practical matter, have an unchallenged and unprecedented monopoly over this vast field of glass-ceramic products.

CONCLUSION.

The decision sought to be reviewed utterly ignores several fundamental legal principles long applied by this Court in its efforts to prevent patents from becoming devices to exclude the public from vast areas of tremendous technical significance. This petition for a writ of certiorari should therefore be granted.

Respectfully submitted,

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June 1967.

APPENDIX A.

OPINION BELOW.

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 15923 and 15924

CORNING GLASS WORKS,
Appellant in No. 15923,

v.

ANCHOR HOCKING GLASS CORPORATION,
Appellant in No. 15924,

APPEAL AND CROSS-APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF DELAWARE

Argued October 20, 1966

Before MARIS, MCLAUGHLIN and KALODNER, *Circuit Judges.*

OPINION OF THE COURT

(Filed March 20, 1967)

By MCLAUGHLIN, *Circuit Judge.*

On November 8, 1963, plaintiff, Corning Glass Works, filed a complaint charging defendant, Anchor Hocking Glass Corporation, with infringement of both product and process claims of its Stookey patent.[1] In answer, defendant denied the infringement charge and further asserted that plaintiff's patent was invalid because; 1) of indefiniteness, 2) the method claims covered inoperative species, and 3) the

1. Patent No. 2,920,971. Application for the patent was made on June 4, 1956 and the patent issued on January 12, 1960.

claims were not patentable over the prior art. Defendant also charged unenforceability by reason of fraud on the Patent Office and included a declaratory judgment counterclaim. On April 26, 1965 defendant amended its answer and counterclaim. The amended answer was directed at a charge of misuse in connection with plaintiff's alleged unlawful fair trading of its product "Corning Ware".[2] The additional two counts to the counterclaim alleged an antitrust violation and unfair competition with both these charges resting on the contention that plaintiff obtained its patent by intentional fraudulent misrepresentation.

The case was brought to trial in the United States District Court for the District of Delaware before Chief Judge Caleb M. Wright. As set out by the District Court, the issues to be decided were; the validity of the patent, the allegations of fraud and the question of infringement. Counts two and three of defendant's amended counterclaim were dismissed by the court's final judgment of March 29, 1966 and the charge of misuse contained in the amended answer was deferred to a future time.

In his opinion, Corning Glass Works v. Anchor Hocking Glass Corp., 253 F. Supp. 461 (D. Del. 1966), Judge Wright found in favor of the plaintiff on the question of fraud and further that the doctrine of unclean hands was not applicable to the facts in the case. On the allegations of invalidity, the court found that plaintiff's invention was patentable over the prior art and that defendant "failed to make even a prima facie showing of inoperativeness", i.e. that the claims of the patent were too broad. In dealing with defendant's charge that the patent was invalid on the ground that its claims were indefinite and vague, the court was satisfied that the claim language was definite. However, the court found that the patent was unenforceable "* * * because in 1956, when the application was made, and in 1960, when the patent issued, to determine the

2. Trade name given the plaintiff's line of domestic cookware covered by the patent in suit.

percent crystallinity within this 7 to 10% margin of error required costly and lengthy independent experimentation to devise a test to ascertain whether a product was within the bounds of the patent claims." 253 F. Supp. 461 at 479.

The Stookey Patent

The patent in suit was the development of Dr. Stanley Donald Stookey, the present Director of Fundamental Chemical Research at the Corning Glass Works. Dr. Stookey's patent teaches the devitrification or crystallization of glass into a glass ceramic material called Pyroceram. Starting with a glass the process initiates a change so that the end product no longer has the properties of glass but rather crystalline properties.

Glass by its nature is a super cooled liquid which at a high temperature has an amorphous molecular structure unlike the ordered structure of a crystalline material. As the glass is cooled it becomes viscous until it reaches its final rigidity where it has the same molecular structure it possessed as a liquid. A pure transparent glass will not contain any crystals because its molecular structure is not receptive to crystallization. However, if at some point prior to or during the cooling phase small particles or imperfections are introduced, crystallization will occur. These microscopic particles are called nuclei and these nuclei initiate the growth of crystals.

In the manufacturing process of glass, nucleation is synonymous with imperfection, because the area that is crystallized has different properties than the rest of the glass which will weaken the glass to the breaking point or cause undesired opaqueness. Through the discovery of Dr. Stookey, however, the nuclei are artifically introduced so that their production and number are controlled independently of the crystallization of the main body of glass. In the words of Dr. Stookey, "[t]he effect of producing these billions of nuclei throughout the body, the nuclei being

such small particles that they can't be seen except perhaps by the electron miscroscope—they are too small to see with the ordinary optical microscope—but each one of those billions has a similar effect herein producing eventually after heat treatment an individual crystal, and the difference there is that without very much heat treatment each of these crystals grows until it comes into contact with the other crystals growing along with it until finally the material is all crystalline, or essentially all crystalline."

Corning's patent teaches that glass can be converted to a predominately crystalline or semicrystalline ceramic body having "* * * at least 50% by weight * * * of crystallizable glassmaking ingredients, * * *."[3] To identify and determine the quantity of crystals the patent suggests the use of a "* * * conventional X-ray powder spectrometer or diffractometer, equipped with a Geiger counter and a curve—or trace—drawing device, * * *."[4] It was precisely the percent crystallinity and the method measuring that percentage that became the focal point of the District Court's determination to invalidate plaintiff's patent.

The Stookey patent was charged by the defendant to be invalid for vagueness since independent experimentation was required to determine; 1) whether a given glass formula will make a pyroceram, 2) the size of the resulting crystals and whether they interlock and 3) percent crystallinity. Before passing upon defendant's assertions, however, the court deemed it necessary to deal with the preliminary issue of whether the 50% crystallinity criterion was definite within the meaning of 35 U. S. C. A. 112.

Finding that the claim language (50% crystallinity) was definite the District Judge turned to consider whether the limits of the patent were indefinite by the standards of 35 U. S. C. A. 112. The problem of construing the patent's limitations was further complicated by the existence of a 7 to 10% margin of error in measuring percent crystallinity

3. Patent No. 2,920,971, claim #1.
4. Patent No. 2,920,971.

by X-ray diffraction.[5] Thus, the court's basic question was rephrased to discover "whether this 7 to 10% margin of error in determining percent crystallinity is so great as to make the patent claims indefinite with 35 U. S. C. A. 112." 253 F. Supp. 461 at 478.

The court set forth three standards upon which the doctrine of indefiniteness rests; 1) protection of the patentee, 2) the encouragement of the inventive genius of others and 3) the assurance that the subject of the patent will be dedicated ultimately to the public.[6] In light of these standards the court was satisfied that the margin of error was not so large as to be indefinite. The court concluded that where a margin of error does exist in a measuring technique the court should interpret the claims "* * * as narrowly as possible when considering the patentee's protection, * * * and interpreting them broadly when considering the public dedication * * *." 253 F. Supp. 461 at 479. By way of illustration the court pointed out that "* * * if a competitor produced a product which on measurement by X-ray diffraction showed 59% crystallinity, it would be entitled to a judgment of noninfringement because within the limits of measurement preciseness of 10% error it is possible that the competitor's product is only 49% crystalline; consequently it falls outside the claim limits of the patent. Thus the patentee is protected although his protection may be more limited than he desires." 253 F. Supp. 461 at 478, 479.

Even though the claims were found to be definite under 35 U. S. C. A. 112 the District Court declared the patent

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5. There was a dispute between the parties as to whether the court should determine the standards and tests at the time the patent application was made or from the date the patent issued. The court, however, found it unnecessary to resolve the problem because the same 7 to 10% margin of error existed at the time of application and the time of issue.

6. These three standards were established by the Supreme Court in the case of General Electric Co. v. Wabash Appliance Corp., 304 U. S. 364, 369, 58 S. Ct. 899, 82 L. Ed. 1402 (1938).

unenforceable "* * * because in 1956, when the application was made, and in 1960, when the patent issued, to determine the percent crystallinity within this 7 to 10% margin of error required costly and lengthy independent experimentation to devise a test to ascertain whether a product was within the bounds of the patent claims." 253 F. Supp. 461 at 479. In support of its ruling the District Court relies on the Third Circuit case of Standard Oil Co. v. Tide Water Associated Oil Co., 154 F. 2d 579 (3 Cir. 1946), which held at p. 583 that "* * * no inventor may compel independent experimentation by others to ascertain the bounds of his claims." This language was framed by the District Court to encompass the exigencies of the present situation, i.e. that "[a] patentee cannot foist a great financial burden on another to develop a new measurement technique to determine whether he is infringing the patent." 253 F. Supp. 461 at 479. In the opinion of the court Anchor's efforts to determine percent crystallinity within a 7 to 10% range of error involved such an expenditure of funds, with both their own experimentation and in their consultation with others, as to constitute a "great financial burden" and thus render Corning's patent unenforceable.

Measurement of Percent Crystallinity

In our view the District Court erred in finding Corning's patent to be unenforceable, since the standards placed upon this particular patent were, as a matter of law, too strict.

The District Court held that the Corning patent is "* * * a basic and pioneering advance in glass and ceramic technology." 253 F. Supp. 461 at 465. I believe that Dr. Stookey's discovery is, in every sense of the word, a "pioneer"—"* * * a patent covering a function never before performed, a wholly novel device, or one of such novelty and importance as to mark a distinct step in the progress of the art, as distinguished from a mere improve-

ment or perfection of what had gone before." Westinghouse v. Boyden Power Brake Co., 170 U. S. 537 at 561, 562, 18 S. Ct. 707, 42 L. Ed. 1136 (1898). Where the court is confronted with such a pioneer patent liberality becomes the keynote of construction requiring the court to give the patentee a wide breadth of protection in construing the patent claims and specifications, Sessions v. Romadka, 145 U. S. 29, 12 S. Ct. 799, 36 L. Ed. 609 (1892); Consolidated Window G. Co. v. Window G. Mach. Co., 261 F. 362 (3 Cir. 1919), cert. den. 251 U. S. 558, 40 S. Ct. 179, 64 L. Ed. 413 (1920); Etten v. Kauffman, 121 F. 2d 137 (3 Cir. 1941).

Until the development of Pyroceram by Dr. Stookey crystallized glass accounted for only a fraction of the total world glass production.[7] Glasses that were intentionally crystallized were opal (light-diffusing) glasses which contained at most 10% crystallinity. The only crystallized composition which approached the 50% requirement was a process invented by Dr. Stookey himself called Fotoform. The crystallinity of this process ranges somewhere between 24 and 35 percent. The success of Pyroceram ushered in a new era in the field of crystallized glass and glass ceramics. Dr. Stookey's discovery was found to possess properties which set it apart from any prior development in the art. Pyroceram's thermal, abrasive and dielectric features made it particularly adaptable to a wide variety of commercial applications—from cooking ware to guided missiles and deep sea diving vessels.

Section 112, 35 U. S. C. A. is designed to protect the patentee and encourage experimentation in the area not covered by the patent. The courts are required to reconcile these conflicting concepts but as this court pointed out in Jones Knitting Corporation v. Morgan, 361 F. 2d 451, 454 (3 Cir. 1966), "* * * each case presents a different question, and the rule is not a technical one, but one made to

7. Dr. Stookey testified that "* * * about 99 per cent of all glass that is made in the world is completely transparent and free of crystals."

protect the public." With this in mind it should be noted that the law provides guidelines to aid the court in balancing these concepts. Where the art is crowded the claims must be certain and definite enough to distinguish the patent from prior discoveries, Barkeij v. Lockheed Aircraft Corp., 210 F. 2d 1 (9 Cir. 1954). Where the patent is a pioneer in the art the necessity to distinguish previous inventions is not as demanding, but a sufficiently precise description is still required to "* * * clearly circumscribe what is foreclosed from future enterprise." United Carbon Co. v. Binney Co., 317 U. S. 228, 236, 63 S. Ct. 165, 87 L. Ed. 232 (1942).

The important problem before us is whether Corning's patent lacked such precision in description as to compel "* * * costly and lengthy independent experimentation to devise a test to ascertain whether a product was within the bounds of the patent claims." 253 F. Supp. 461 at 479. To phrase the question more precisely under the corollary test of the District Court, the patent's invalidity rises and falls with the evaluation of whether Corning foisted a great financial burden upon Anchor "* * * to develop a new measurement technique to determine whether he [Anchor] is infringing the patent." 253 Supp. 461 at 479. For the reasons that follow we believe the question must be answered in the negative.

The Corning patent teaches that its process results in a composition which contains 50% crystallinity by weight. In order to measure the weight percentage crystallinity the patent refers to the use of the X-ray diffraction method. The District Court indicated that Corning, in 1956 and in 1958, was unable to measure the percent crystallinity within the 7 to 10% range of error by X-ray diffraction. It was not until 1964, after a year of independent experimentation, that plaintiff refined its X-ray diffraction technique down to a 4 to 5% margin of error. Because of the uncertainty of the X-ray diffraction method defendant was forced to spend time and money in the development of its own

testing methods and this in the opinion of the District Court invalidates the patent. Juxtaposed against the narrow interpretation of the patentee's claims the result reached by the District Judge was inevitable. Once, however, the District Court's cloak of strictness has been removed, and the broad construction due this pioneer patent is applied, it becomes evident that Anchor was not under any burden in determining whether or not it was infringing plaintiff's patent.

In interpreting the claims and specifications the District Court relied too heavily on the 50% crystallinity standard set forth in the patent. In his own words Dr. Stookey stated that the process he invented was designed to convert glass "* * * to something that has not the properties of glass basically but the properties of crystals." The first paragraph of the patent explains that the process is concerned with changing preformed glass articles "* * * to predominantly crystalline or semicrystalline ceramic bodies * * *." It is quite apparent that the designation of 50% crystallinity was an effort to describe the conversion of a glass to a predominantly crystalline body and not an arbitrary point at which the patentee wished to assert a monopoly. On cross-examination Dr. Stookey clearly stated the purpose of his invention:

> "To my mind and certainly the original purpose of the invention whether it is 40 or 45 or 50 or 55 per cent is not critical. The purpose of the invention is to change a glass to a material with substantially different properties, predominantly crystalline, and for that reason I don't consider that any one particular percentage makes any sharp dividing line.
>
> * * *
>
> "There is this gray area in which any of the properties may be changing, but it is not possible to set one particular percentage, like 49 per cent, as the dividing line between a crystal and a glass. But all of

the glasses that have been known to me from the past have been glass with perhaps a maximum of 10 to 15 per cent of crystals.

"I mentioned my own invention of FOTOFORM in which after heating to the etching stage, there was about 24 per cent to 35 per cent crystals. This is the only example of a glass that I know of that had that much crystallinity. So I am distinguishing between the two ends of the scale really and doing my best in the patent to describe this."

The District Court noted that "[t]he change in properties begins at approximately 40% crystallinity and in most cases is complete at 60%. 253 F. Supp. 461 at 479. Since a patentee is under no obligation to claim the limits of his invention that portion of plaintiff's patent between 40 and 50% crystallinity was considered by the court to be dedicated to the public. However, the testimony of Dr. Stookey demonstrated that no such public surrender was intended by Corning. The law is settled that a patent should not be struck down or its claims unnecessarily limited where a reasonable construction of the specifications and claims will protect the invention, 4 Deller's Walker on Patents, Sec. 242, p. 118 (2d ed. 1965). If such a construction is applied in this case the Stookey patent's sphere of protection will extend to 40% crystallinity. Nor would giving the plaintiff a patent monopoly in the area of 40% crystallinity violate the provisions of 35 U. S. C. A. 112 because as previously stated, the 50% crystallinity standard must be read in the light of the patent's overall purpose, which is to convert preformed glass articles to predominantly crystalline or semicrystalline ceramic bodies. In dealing with Section 112 the Second Circuit stated in Georgia-Pacific Corp. v. United States Plywood Corp., 258 F. 2d 124 (2 Cir. 1958), cert. den., 358 U. S. 884, 79 S. Ct. 124, 3 L. Ed. 2d 112 (1958):

"On the other hand, patentable inventions cannot always be described in terms of exact measurements, symbols and formulae, and the applicant necessarily must use the meager tools provided by language, tools which admittedly lack exactitude and precision. If the claims, read in the light of the specifications, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more." 258 F. 2d 124 at 136.

Examining the District Court's narrowly interpreted conclusion in a more favorable posture toward the patentee it is clear that Anchor was not unduly burdened in establishing the bounds of the Corning patent. The opinion of the District Judge explained that in 1958 Corning was unable to determine percent crystallinity by X-ray diffraction or electron microscopy, although, the court conceded, "* * * it was possible to determine this percentage roughly by chemical analysis." 253 F. Supp. 461 at 480. The chemical analysis test, though not set forth in plaintiff's patent as a means of measuring percent crystallinity, was, nevertheless, a common and inexpensive method available to Anchor to determine the limits of the Stookey patent. Quantitative measurement by chemical analysis is a first principle of any scientific investigation and its employment, if not explicit, would certainly be implied. Further, the X-ray diffraction test was by no means lacking as a method of calculating the patent claims. The testimony of Anchor's own witness, Dr. Rustin Roy, showed that in 1956 percent crystallinity could be determined with considerable accuracy. The testimony read:

"Q. Do you think, Dr. Roy, that you personally would have been unable to determine the weight percentage of spodumene crystals in one of these products in 1956 so that your results were no more accurate than plus or minus 10 per cent using the best techniques and

intelligence, and so on, that you had? A. I would give myself about 8 per cent maybe.

Q. You think you might do just a little bit better? A. Just a little."

The evidence indicates that defendant could adequately measure the patent claims and that the "great financial burden" was not foisted upon but rather assumed by Anchor in an effort to distinguish or break the Stookey patent—not to determine its limits. In a letter of March 21, 1960 to Dr. W. A. Weyl of Pennsylvania State College, Paul D. Dilliard, the Technical Director of Practical Research at Anchor, acknowledged that defendant's developments would infringe on Corning's patent rights [8] and Dr. Dilliard testified to this fact in his deposition.[9]

From the facts and circumstances concerning this invention and under the sound law of the case the only reasonable conclusion is that the patent was sufficiently described so that those who are skilled in the art were apprised of the patent claims and specifications without being forced to engage in costly independent experimentation.

We have examined at length the contentions of the appellee cross-appellant concerning other alleged sources of indefiniteness in the Stookey patent not specifically dealt

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8. The pertinent part of the letter reads: "As you will note from this patent the process is such that our own developments would infringe on the patent rights. It is our present understanding from our patent attorney that if it can be shown that either all or part of the claims in this patent have been known or practiced prior to the patent application, there is a possibility of breaking the patent. It is also our understanding that the major key or claim in this patent is the fact that the resulting product is 50% or more crystal. It is these two points which we need to resolve before decisions can be made as to the present standing of our development."

9. "Q. Now, the letter you wrote Dr. Weyl goes on to state, 'As you will note from this patent the process is such that our own developments would infringe on the patent rights.' Were they referring to the Stookey patent here in suit? A. That is right, yes.

Q. And was that your understanding of the situation at that time? A. That is correct."

with in the opinion below, alleged fraud on the Patent Office by appellant and alleged invalidity of the Stookey patent over the prior art. We find all of these to be without merit. It remains to be said that the patent here found valid is a great basic invention which has brought substantial benefit to the public at large.

The judgment of the District Court dismissing the complaint and granting the declaratory judgment sought by Count 1 of the defendant's counterclaim and declaring invalid each and every claim of U. S. Patent No. 2,290,971 will be reversed and this cause will be remanded to the District Court with direction to enter judgment in favor of plaintiff-appellant. The dismissal by the District Court of Counts 2 and 3 of defendant's counterclaim will be affirmed. The question of infringement by defendant of plaintiff's patent which quite properly under the trial decisional circumstances was not passed upon by the District Court, will be remanded to that Court for its consideration.

APPENDIX B.

JUDGMENT BELOW.

[Caption omitted.]

Present: MARIS, MCLAUGHLIN and KALODNER, *Circuit Judges.*

JUDGMENT.

This cause came on to be heard on the record from the United States District Court for the District of Delaware and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that those parts of the judgment of the District Court, filed March 29, 1966, dismissing the complaint and granting the declaratory judgment sought by Count 1 of the defendant's counterclaim and declaring invalid each and every claim of U. S. Patent No. 2,290,971 be and the same are hereby reversed and the cause remanded to the District Court with direction to enter judgment in favor of plaintiff-appellant; that part of the judgment of the District Court, filed March 29, 1966, which dismissed Counts 2 and 3 of defendant's counterclaim be, and the same is hereby affirmed; the question of infringement by defendant of plaintiff's patent which quite properly under the trial decisional circumstances was not passed upon by the District Court be, and the same is hereby remanded to the District Court for its consideration. Costs taxed in favor of plaintiff.

ATTEST:

THOMAS F. QUINN

Clerk.

March 20, 1967.